

### **REMARKS/ARGUMENTS**

The Examiner has rejected: (1) Claims 1-30 under 35 U.S.C. § 112; (2) Claims 1 and 17 under 35 U.S.C. § 101; (3) Claims 1-25 and 27-30 under 35 U.S.C. § 102(e); and (4) Claim 26 under 35 U.S.C. § 103. Applicants have amended each of the application's independent claims (Claims 1, 10, and 17) and have canceled dependent Claims 8 and 18. Accordingly, Claims 1-7, 9-17, and 19-30 remain pending in the application. Applicants' remarks regarding the current claim rejections are provided below.

#### **Rejection of Claims 1-30 under 35 U.S.C. §112**

The Examiner has rejected independent Claims 1, 10, and 17 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner has further rejected independent Claim 1 under 35 U.S.C. § 112, second paragraph as failing to include the steps of "evaluating or reviewing the service contract and how to provide the insurance coverage", which the Examiner has asserted constitute essential steps of Claim 1. The Examiner has further rejected Claims 2-9, 11-16 and 18-30 as being dependant, respectively, on independent claims that were rejected under 35 U.S.C. § 112, second paragraph. In addition, the Examiner has rejected Claims 27 and 29 under 35 U.S.C. § 112, second paragraph as being indefinite and unclear.

For the purpose of facilitating prosecution of the present application, Applicants have amended independent Claims 1, 10, and 17 (and various of the application's dependent claims) to more particularly define the claimed invention. Applicants respectfully assert that the application's claims, as amended, satisfy the requirements of 35 U.S.C. § 112. Accordingly, Applicants respectfully request that the current rejections under 35 U.S.C. § 112 be withdrawn.

#### **Rejection of Claims 1 and 17 under 35 U.S.C. §101**

Independent Claims 1 and 17 have been rejected under 35 U.S.C. § 101 as not providing a useful, concrete, and tangible result. Applicants respectfully assert that Claims 1 and 17, as amended, provide a useful, concrete and tangible result. For example, Claim 1 includes the step of providing, at no cost to a particular customer,

insurance coverage that protects the customer against one or more events selected from a group consisting of: (A) loss of a particular article of personal property, (B) theft of the article of personal property, and (C) other named perils associated with the article of personal property. Similarly, Claim 17 is directed to a property protection program that includes insurance coverage that protects a customer against one or more events selected from a group consisting of: (A) loss of a particular article of personal property, (B) theft of the article of personal property, and (C) other named perils associated with the article of personal property. Accordingly, because the provision of insurance provides concrete financial benefits to customers upon the occurrence of specified events (such as those listed in Claims 1 and 17, above), Applicants respectfully assert that Claims 1 and 17 provide a useful, concrete, and tangible result as required by 35 U.S.C. § 101. Accordingly, Applicants respectfully request that the current rejection of Claims 1 and 17 under 35 U.S.C. § 101 be withdrawn.

**Rejection of Independent Claims 1, 10, and 17 under 35 U.S.C. 102(e)**

The Examiner has rejected Claims 1, 10, and 17 as being anticipated by *Becker et al.* ("*Becker*"). Applicants note that *Becker* teaches a method of "bundling" a database registration service with a loss protection service. (See *Becker*, Paragraph 0008, Lines 6 – 11). As discussed in Paragraph 0014 of *Becker*, the database registration service described in *Becker* simply involves entering detailed information regarding particular gemstones in a database. This information is later used, as necessary, to identify the gemstones.

As discussed in Paragraph 0017 of *Becker*, the loss protection service of *Becker* serves to insure the registered gemstones against various events such as loss and theft.

Applicants note that *Becker* only teaches providing a single type of mechanism (the loss protection service) that would provide a remedy to an owner of gemstones in the event that the gemstones become unusable for their intended purpose. The database registration service merely serves to facilitate the implementation of the loss protection service (e.g., by providing information that is useful in confirming that a particular damaged gemstone is a particular gemstone that is covered under the loss protection service (rather than just a similar gemstone)).

Applicants respectfully assert that *Becker* does not teach each element of amended Claims 1, 10, and 17 as required by 35 U.S.C. 102(e). For example, *Becker* does not teach or suggest “selling, by (a) first party, a service contract to (a) customer, said service contract providing protection against the mechanical breakdown or other failure of said article of personal property; and in response to said customer purchasing said service contract, providing, at no cost to said customer, insurance coverage that protects said customer against one or more events selected from a group consisting of: (A) loss of said article of personal property, (B) theft of said article of personal property, and (C) other named perils associated with said article of personal property”, as required by Claim 1.

By the same token, *Becker* does not teach the following limitations of Claim 10:

“determining whether said item requires replacement or repair due to:  
(1) an event covered under a service contract provided by a first provider, or  
(2) an event covered under an insurance policy provided by a second provider;

in response to determining that said item requires replacement or repair due to an event covered under said service contract, submitting a request to said first provider to process said item according to said service contract; and

in response to determining that said item requires replacement or repair due to an event covered under said insurance policy, submitting a request to said second provider to process said item according to said insurance policy, wherein:

said step of determining whether said item requires replacement or repair due to an event covered under said service contract comprises:

(A) determining whether said item has incurred a mechanical breakdown; and

(B) in response to determining that said item has incurred a mechanical breakdown, determining that said item requires replacement or repair due to an event covered under said service contract;

said step of determining whether said item requires replacement

or repair due to an event covered under said insurance policy comprises:

(A) determining whether said item has been damaged; and

(B) in response to determining that said item has been damaged, determining that said item requires replacement or repair due to an event covered under said insurance policy.”

Similarly, *Becker* does not teach or suggest a “unified property protection program comprising: (A) a service contract that is paid for by a first entity, said service contract providing protection against the mechanical breakdown or other failure of an article of personal property; and (B) insurance coverage that is paid for by a second entity, said insurance coverage providing protection against one or more events selected from a group consisting of: (1) loss of said article of personal property, (2) theft of said article of personal property, and (3) other named perils associated with said article of personal property”, as required by independent Claim 17.

For the reasons set forth above, Applicants respectfully assert that *Becker* does not teach or suggest all of the limitations of Claims 1, 10, and 17. Accordingly, Applicants respectfully request that the current rejection of these claims under 35 U.S.C. § 102(e) be withdrawn.

#### **Rejection of Dependent Claims 2-7, 9, 11-16, and 19-30 under 35 U.S.C. § 102(e)**

Dependent Claims 2-7, 9, 11-16, and 19-30 have been rejected under 35 U.S.C. § 102(e) and/or 35 U.S.C. § 103. Applicants note that Claims 2-7 and 9 depend from independent Claim 1; Claims 11-16 depend from independent Claim 10; and Claims 19-30 depend from independent Claim 17. Accordingly, for the reasons noted above in regard to independent Claims 1, 10, and 17, Applicants respectfully request withdrawal of the current rejection of these claims under 35 U.S.C. § 102(e) and/or 35 U.S.C. § 103.

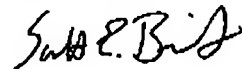
#### **Conclusion**

In light of the above, Applicants respectfully assert that Claims 1-7, 9-17, and 19-30 are in condition for allowance and such action is respectfully requested. Applicants

would welcome a call from the Examiner to expedite prosecution of the present application. Applicant's patent attorney, Scott Brient, may be reached directly at (404) 881-7728.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



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I hereby certify that this paper is being facsimile transmitted to the U.S. Patent and Trademark Office Fax No. (571) 273-8300 on the date shown below.

  
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Scott E. Brient

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